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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,332	07/02/2001	Douglas A. Neidich	8-4710	2072

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Thomas Hooker, Esq.
Thomas Hooker, P.C.
Suite 304
100 Chestnut Street
Harrisburg, PA 17101

EXAMINER

GRAYBILL, DAVID E

ART UNIT	PAPER NUMBER
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2827

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/897,332	NEIDICH, DOUGLAS A.	
	Examiner	Art Unit	
	David E Graybill	2827	

-- Th MAILING DATE of this communication app ars on th cover sheet with th correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 47-52 is/are allowed.
- 6) ☒ Claim(s) 38-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____ |

Linking claim 47 is allowed. Since the restriction requirement between inventions I and II, as set forth in the paper mailed on 12-18-2, was conditioned on the nonallowance of the linking claim(s), **the restriction requirement as to the linked inventions is hereby withdrawn.** Claims 43, 51 and 52, previously withdrawn from consideration as a result of the restriction requirement, are hereby rejoined and fully examined for patentability under 37 CFR 1.104. In view of the withdrawal of the restriction requirement as to the linked inventions, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 38-42 and 44-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following claim language lacks sufficient antecedent basis:

Claim 38, "the thickness of the arm," "the junction of the edge and the first arm surface," "the junction of the edge and the second arm surface," and "such pad";

Claims 38 and 39, "the first contact pad";

Claim 39, "said spring arm";

Claim 41, "said spring contact";

Claim 43, "said pad" (ambiguous), and,

Claim 44, "the other end of the arm."

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 38 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Grabbe (5380210).

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At column 2, line 60 to column 3, line 19, column 3, lines 46-53, column 4, lines 19-31, and column 4, line 65 to column 5, lines 4, Grabbe teaches a contact for forming electrical connections with a contact pad, the contact comprising an arm 22 stamp-formed from strip stock, the arm having first 47 and second 49 surfaces separated by the thickness of the arm and two opposed shear edges (at the tip of 32 and 34, illustrated but not labeled), each shear edge extending across the thickness of the arm and including a shear-formed rounded corner at the junction of the edge and the first arm surface (illustrated but not labeled) and a shear-formed sharp corner at the junction of the edge and the second arm surface (formed by the junction of the plane of the edge and the plane of the second surface, illustrated but not labeled); a first contact point at one shear edge (point contacting 16, illustrated but not labeled); and a second contact point at the other shear edge (point contacting 16a, illustrated but not labeled), each contact point extending above the arm so that the rounded edge corner at the point is positioned above said first arm surface and faces away from such surface; wherein upon relative movement of the contact toward the first contact pad the contact points engage such pad at the rounded corners to form redundant electrical connections

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therewith wherein said contact points are located on portions of said arm bent above said first arm surface.

To further clarify the teachings, "each contact point extending above the arm so that the rounded edge corner at the point is positioned above said first arm surface and faces away from such surface," and, "wherein said contact points are located on portions of said arm bent above said first arm surface," it is noted that the arm is bent. Furthermore, the disclosed product of Grabbe is not limited to an absolute frame of reference or otherwise limited to a particular orientation, and it is inherent that there is a frame of reference wherein these positional limitations are satisfied.

To further clarify the teaching, "wherein upon relative movement of the contact toward the first contact pad the contact points engage such pad at the rounded corners to form redundant electrical connections therewith," it is noted that this limitation is a statement of intended use of the product which does not result in a structural difference between the claimed product and the product of Grabbe. Further, because the product of Grabbe has the same structure as the claimed product, it is inherently capable of being used for the intended use, and the statement of intended use does not patentably distinguish the claimed product from the product of Grabbe. Similarly, the

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manner in which a product operates is not germane to the issue of patentability of the product; Ex parte Wikdahl 10 USPQ 2d 1546, 1548 (BPAI 1989); Ex parte McCullough 7 USPQ 2d 1889, 1891 (BPAI 1988); In re Finsterwalder 168 USPQ 530 (CCPA 1971); In re Casey 152 USPQ 235, 238 (CCPA 1967). Also, "Inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims."; In re Young, 25 USPQ 69 (CCPA 1935) (as restated in In re Otto, 136 USPQ 458, 459 (CCPA 1963)). And, claims directed to product must be distinguished from the prior art in terms of structure rather than function. In re Danley, 120 USPQ 528, 531 (CCPA 1959). "Apparatus claims cover what a device is, not what a device does [or is intended to do]." Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 39, 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grabbe (5380210).

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As cited, Grabbe teaches wherein the spring contact has a thickness of about 0.0017 inches, the rounded corners have an inherent radius of curvature, and the portions comprise ears 32, 34, each having an inherent longitudinal radius of curvature.

However, Grabbe does not appear to explicitly teach the contact including conductive plating on said spring arm at said contact points so that said plating engages the first contact pad.

Nonetheless, as cited, Grabbe teaches that conductive plating ("electroplated") on a spring arm is conventional. Moreover, it would have been obvious to use the conventional electroplated spring arm as the spring arm of Grabbe because Grabbe requires a spring arm, and it would provide a spring arm. See MPEP 2144.07 "Art Recognized Suitability for an Intended Purpose."

Moreover, it is noted that the limitation, "so that that said plating engages the first contact pad," is a statement of intended use of the product which does not result in a structural difference between the claimed product and the product of the applied prior art. Further, because the product of the applied prior art has the same structure as the claimed product, it is inherently capable of being used for the intended use, and the statement of intended use does not patentably

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distinguish the claimed product from the product of the applied prior art.

Also, Grabbe does not appear to explicitly teach that the rounded corners have a radius of curvature between about 0.006 inches and about 0.0010 inches, and the ears each have a longitudinal radius of curvature of about 0.012 inches.

Nevertheless, Notwithstanding, it would have been an obvious matter of design choice bounded by well known manufacturing constraints and ascertainable by routine experimentation and optimization to choose these particular dimensions because applicant has not disclosed that the dimensions are for a particular unobvious purpose, produce an unexpected result, or are otherwise critical, and it appears prima facie that the process would possess utility using another dimension. Indeed, it has been held that mere dimensional limitations are prima facie obvious absent a disclosure that the limitations are for a particular unobvious purpose, produce an unexpected result, or are otherwise critical. See, for example, *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984); *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

Claims 47-52 are allowed.

Claims 43-46 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Applicant's remarks filed 4-21-3 have been fully considered and rendered moot by the rejections and indication of allowability supra.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than
SIX MONTHS from the mailing date of this final action.

***Any telephone inquiry of a general nature or relating to the status (MPEP
203.08) of this application or proceeding should be directed to Group 2800
Customer Service whose telephone number is 703-306-3329.***

Any telephone inquiry concerning this communication or earlier communications from
the examiner should be directed to David E. Graybill at (703) 308-2947. Regular office hours:
Monday through Friday, 8:30 a.m. to 6:00 p.m.

The fax phone number for group 2800 is 703/308-7722.



David E. Graybill
Primary Examiner
Art Unit 2827

D.G.
21-Aug-03